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**This Opinion is Not
Citable as Precedent
of the TTAB**

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Active Organics, Inc.

Serial No. 78116593

John E. Vandigriff, Esq. for Active Organics, Inc.

Tina L. Snapp, Trademark Examining Attorney, Law Office 116
(Meryl Hershkowitz, Managing Attorney).

Before Quinn, Holtzman and Rogers,
Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

Active Organics, Inc. [applicant] has applied to register ACTIVE ORGANICS as a trademark for goods ultimately identified as "botanical extracts for use in making cosmetics," in Class 1; "naturally derived materials used alone or as ingredients in the preparation of cosmetics, namely, anti-aging creams and aromatherapy oils," in Class 3; "naturally derived pharmaceutical preparations for the treatment of dry and chaffing [sic]

skin, for use as an end product and for manufacturing use," in Class 5; and "food flavoring additives for non-nutritional purposes," in Class 30. Registration has been refused under each of two sections of the Trademark Act.

First, the examining attorney has refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), in view of the prior registration of the identical mark ACTIVE ORGANICS for goods identified as "astringents for cosmetic purposes, bath gel, bath oil, bath powder, body cream, body oil, hand cream, night cream, personal deodorants, deodorants and antiperspirants, essential oils for personal use, hair gel, shower gel, non-medicated hair care preparations, hair cleaning preparations, hair rinses, hair spray, hair styling preparations, lipstick, skin moisturizer, skin lotion, soap, skin soap, skin toners, deodorant soap, liquid soaps for hands, face and body," in Class 3.¹ Second, the examining attorney has refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), asserting that ACTIVE ORGANICS is a descriptive term when used on or in connection with applicant's identified goods.

¹ Registration no. 2392412, on the Supplemental Register, issued October 3, 2000, and asserts dates of first use and first use in commerce of November 24, 1999.

Applicant has appealed from each of these refusals. Applicant and the examining attorney have filed briefs, but applicant did not request an oral hearing.

As to the first of the two grounds for refusal, the examining attorney essentially contends that applicant's mark and the mark in the cited registration are identical, i.e., both marks are ACTIVE ORGANICS in typed form; that the goods of applicant and the registrant need not be as similar or as related, for there to be a likelihood of confusion, as when the goods of an applicant and a registrant are marketed under marks which are merely similar, but not identical; and that the respective goods of applicant and registrant are related insofar as applicant's Class 1 "botanical extracts for use in making cosmetics" could be used to make registrant's goods, and insofar as applicant's Class 3 "naturally derived materials used alone or as ingredients in the preparation of cosmetics, namely, anti-aging creams and aromatherapy oils" assertedly fall within the scope of registrant's identified goods. In regard to the examining attorney's assertion that the applicant's and registrant's Class 3 goods overlap, the examining attorney apparently reads the applicant's Class 3 identification as encompassing, inter alia, anti-aging creams and aromatherapy oils and considers

these within the scope of registrant's identified creams and oils. Brief, p. 6. These arguments, set forth in the Office actions refusing registration and in the examining attorney's brief, specifically target the application insofar as it seeks registration of applicant's mark in Classes 1 and 3.² In the brief, the examining attorney also sets forth a rationale for refusing registration in Class 5, specifically, that applicant's Class 5 goods are likely to be marketed in the same channels of trade as both applicant's and registrant's respective Class 3 goods. Brief, pp. 6-7. No specific argument is advanced as to why there would be a likelihood of confusion given registrant's use of its mark on the goods listed in its registration and applicant's use of the same mark on applicant's identified "food flavoring additives for non-nutritional purposes," in Class 30.

Applicant, in regard to the Section 2(d) refusal, argues that it first used its mark on December 10, 1981, and has continuously used the mark since then; that the mark has become well-known and associated with applicant and its products for 22 years, and that such association should mean that there will be no confusion; that the

² The examining attorney also asserts that applicant's "cosmetics and cosmetic ingredients" are within the natural field of

registrant has only used its mark since November 24, 1999; that registrant has not asked applicant to stop using the mark because it knows it "would lose" because of applicant's "prolonged use"; and that applicant has used the mark in four classes, while registrant has used the mark only in one class, which "gives Applicant a wider exposure to the various industries who recognize and associate the mark with the Applicant." Brief, p. 3.

The examining attorney notes that applicant does not argue that the marks differ, or that the goods are not related, and objects to applicant's argument that it is the prior user of the involved mark as an impermissible collateral attack on the cited registration. We agree that applicant's argument, insofar as it asserts registrant "would lose" a priority contest, is an impermissible collateral attack on the cited registration. In re Calgon Corporation, 435 F.2d 596, 168 USPQ 278, 280 (CCPA 1971). Nor can we accept applicant's argument insofar as applicant is asserting that the involved mark is more closely associated with applicant than with registrant. This, of course, is pure speculation and, in any event, does not preclude the possibility of confusion among consumers; it

expansion of the registrant. There is no evidence, however, referenced as supporting this conclusion.

only suggests that the confusion would more likely be of applicant's customers than of registrant's customers.

When, as in this case, the involved marks are identical, this "weighs heavily against applicant." In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984). With identical marks, their contemporaneous use can lead to the assumption that there is a common source "even when [the] goods or services are not competitive or intrinsically related." In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993).

We agree with the examining attorney's conclusion that the contemporaneous use of ACTIVE ORGANICS on the goods identified in the involved registration and for the Class 3 and Class 5 goods in the involved application would be likely to cause confusion. These items are very similar in type and the examining attorney is correct in observing that they can, because there are no restrictions as to classes of consumers, be presumed to be marketed to the same classes of consumers. Applicant's Class 1 and Class 30 goods, however, are further removed from the goods in the registration and can be presumed, even without a specifically stated restriction, to be marketed to

different classes of consumers, primarily manufacturers.³ At a minimum, this injects into this case some doubt about whether those manufacturers of cosmetics would be confused by the contemporaneous use of ACTIVE ORGANICS for registrant's cosmetic and personal care products and applicant's "botanical extracts for use in making cosmetics," and even greater doubt about whether purchasers or users of "food flavoring additives for non-nutritional purposes" would be confused by the contemporaneous use of the same mark for such products and for registrant's cosmetics and personal care items.

The examining attorney bears the burden of presenting a prima facie case in support of the Section 2(d) refusal, as to each class in applicant's multi-class application. We conclude that the burden has been met only in regard to applicant's request for registration of ACTIVE ORGANICS in classes 3 and 5. The examining attorney has put in no evidence that botanical extracts for use in making cosmetics on the one hand, and cosmetics and personal care items on the other are related, for likelihood of confusion

³ Applicant's Class 1 goods would appear to be marketed exclusively to manufacturers of cosmetics. Applicant's Class 30 goods clearly could be marketed to manufacturers of food products, but the possibility exists that they might also be marketed at retail to home cooks who want to add food flavorings to their dishes.

purposes. It is manifestly insufficient for the examining attorney to merely argue that the former are utilized in the making of the latter. This does not show that purchasers or users of the extracts would be the same class of consumers as purchasers or users of the finished products. The failure of proof is more glaring in regard to applicant's Class 30 goods, as the examining attorney has not even presented an argument why purchasers or users of food flavoring additives would be confused by the use of the same term on or in conjunction with cosmetics and personal care items.

We reverse the Section 2(d) refusal of registration in regard to Classes 1 and 30; we affirm that refusal as to Classes 3 and 5. That applicant may be the prior user and should not be cast in the role of a latecomer who has adopted another's mark at its peril is not an issue with which we can grapple in this ex parte proceeding. That is an issue to be raised in an appropriate inter partes proceeding.

Turning to the second ground for refusal, i.e., the Section 2(e)(1) refusal to register ACTIVE ORGANICS on the theory that it is descriptive of applicant's various products, we affirm the refusal of registration as to all classes.

In response to the initial Office action refusing registration, applicant submitted a piece of literature concerning its products that states (emphasis added) that its manufacturing facilities "create the finest Botanical and Live Cell Extracts" by using "the highest caliber raw materials available and by using a superior 'European Cold Process' extraction method to preserve the *activity* of each ingredient." The brochure also lists various plant extracts and animal tissue extracts among the available products of applicant. We take judicial notice that active is defined to mean, among other things, "effective (opposed to *inert*): *active ingredients*," and that organic is defined to mean, among other things, "characteristic of, pertaining to, or derived from living organisms." The Random House College Dictionary pp. 14 and 936 (Rev. ed. 1982).⁴

The identifications of applicant's various products, not being restricted in any way, would encompass organic products derived from plant or animal tissue and, products that are active rather than inert. Moreover, based on applicant's brochure, its products appear to be biologically or physiologically active organic products.

⁴ The Board may take judicial notice of dictionary definitions. See University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 213 USPQ 594 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); Marcal Paper Mills, Inc. v. American Can Co., 212 USPQ 852 (TTAB 1981).

Thus, both ACTIVE and ORGANICS are descriptive of products highlighted in applicant's brochure and encompassed by its identifications.

In regard to the use of ACTIVE ORGANICS as descriptive or non-distinctive terms for products such as applicant's, we note that the examining attorney has introduced into the record various excerpts retrieved from the NEXIS database, including the following: "...a new collection of skin-care products that contain hydrolyzed pearl extract, Vitamin C and active organics that brighten skin tone, reflect light and soften the appearance of fine lines and wrinkles."

Belleville News-Democrat, December 22, 2001. In addition, the cited registration of ACTIVE ORGANICS for the Section 2(d) refusal is on the Supplemental Register. Finally, we note that the examining attorney has entered into the record various registrations for marks on the Principal Register each of which includes the term ORGANICS and a disclaimer of exclusive rights to that term. These registrations cover cosmetics and personal care products, food products, and vitamins and pharmaceutical products.

On this record, we have no doubt that the examining attorney has made out a prima facie case for refusal of registration under Section 2(e)(1). In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987) (examining attorney

bears burden of establishing prima facie case of descriptiveness; proposed mark is considered merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Lanham Act, if it immediately describes an ingredient, quality, characteristic or feature thereof, or if it directly conveys information regarding the nature, function, purpose or use of the goods or services); see also, In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-218 (CCPA 1978).

Applicant argues that ORGANIC has various meanings; that the various third-party registrations with disclaimers of ORGANICS were not refused registration as descriptive; that applicant's mark has been used since a date prior to the registration of the third-party registrations; and that "if Applicant elected to have the mark registered under the Supplemental Register, the normal five years of use has been greatly exceed[ed] and it would be transferred to the Principal Register."

That ORGANIC is a term with various meanings does not mean that the term ORGANICS is not descriptive when used on or in connection with applicant's products. It is, of course, well settled that the question whether a term is merely descriptive is determined not in the abstract but, rather, in relation to the goods or services for which

registration is sought, the context in which it is being used on or in connection with those goods or services and the possible significance that the term would have to the average purchaser or user of the goods or services. See In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979) and In re Recovery, 196 USPQ 830, 831 (TTAB 1977).

That the various third-party registrations were not refused is not the point of the examining attorney. The point is that the marks in each were registered because the registrants disclaimed exclusive rights in ORGANICS, for products akin to those identified in applicant's application. Thus, the registrations support the conclusion that ORGANICS is a descriptive term when used in conjunction with marketing the goods of applicant.⁵

Finally, the purported long use of applicant's mark is not in issue. Applicant has not sought registration on the Principal Register under Section 2(f) of the Trademark Act and a claim of acquired distinctiveness due to the length and, if true, substantial exclusivity of its use. A term which is descriptive and unregistrable on the Principal Register absent proof of distinctiveness under Section 2(f)

⁵ The registrations, of course, do nothing to establish that ACTIVE is descriptive for applicant's products. We rely on applicant's brochure as evidence of the descriptiveness of that term, as well as the dictionary definition of ACTIVE and the NEXIS excerpts.

is not automatically transferred to, or made automatically eligible for registration on, the Principal Register, merely because it has been used for five years. The user of a term that is descriptive (but not generic) may choose to register the term on the Supplemental Register without any proof of distinctiveness, or may seek registration on the Principal Register with an appropriate showing under Section 2(f). Under the latter option, a claim, if it can be made, of five years substantially exclusive and continuous use *may* be accepted by the Office as *prima facie* proof of distinctiveness; but much more evidence may be required. Thus, contrary to applicant's apparent conclusion, ACTIVE ORGANICS is not eligible for registration on the Principal Register, without resort to a claim of, and submission of proof of, acquired distinctiveness, merely because the application asserts that the mark has been in use for the identified goods for more than five years.

Decision: The refusal of registration under Section 2(d) is reversed as to Classes 1 and 30 but affirmed as to Classes 3 and 5. The refusal of registration under Section 2(e)(1) also is affirmed as to each of the four classes in the application.